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George Gates
GATES & COOPER LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

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Technology Center 2100

In re Application of: Lee Anne KOWALSKI)
Application No. 09/928,599) DECISION ON PETITION FOR
Attorney Docket No. SVL920010049US1) SUPERVISORY REVIEW
Filed: 08/13/2001) UNDER 37 CFR §1.181
For: METHOD AND SYSTEM FOR)
IDENTIFYING AND DISTINGUISHING)
WORDS CONTAINED WITHIN AN)
ELECTRONIC MESSAGE IN ORDER TO)
CONVEY SIGNIFICANCE)

This is a decision on the petition under 37 CFR § 1.181, filed October 25, 2006 requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the Final Office action mailed October 5, 2006 and to request review of the sufficiency and propriety of the declarations under 37 C.F.R. §1.131 filed on September 20, 2005, February 27, 2006 and July 19, 2006.

The petition is **GRANTED**.

RECENT PROSECUTION HISTORY

- (1) On November 29, 2005, a non-final Office action, treating all pending claims, was mailed. The Office action found the declaration and evidence submitted under 37 C.F.R. §1.131 on September 20, 2005 to be insufficient for various reasons as outlined therein.
- (2) On February 27, 2006, an amendment, response, further evidence and a declaration under 37 C.F.R. §1.131 were filed by Applicant.
- (3) On April 25, 2006, a final Office action, treating all pending claims, was mailed. This action provided rational for the insufficiency of the declaration and evidence filed on February 27, 2006 under 37 CFR §1.131.
- (4) On July 19, 2006, an amendment, remarks, an additional declaration and evidence under 37 C.F.R. § 1.131 and Request for Continuing Examination were filed.
- (5) On October 5, 2006, a final Office action was mailed, including supporting rationale for the insufficiency of the declaration and evidence filed on July 19, 2006 under 37 CFR §1.131.

- (6) On October 25, 2006, the instant petition under 37 C.F.R. §1.181 was filed.
- (7) On January 5, 2007 a notice of appeal was filed.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the following relief: withdrawal of the finality of the October 5, 2006 office action as prosecution was alleged to have been prematurely closed; and review of the sufficiency and propriety of the declarations under 37 C.F.R. §1.131, in accordance with M.P.E.P. 715.08.

REQUIREMENTS

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181(f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.

The petition initially filed on October 25, 2006 includes elements (1) and (2) above. The petition was filed within two months of the final Office action from which the relief is requested.

ANALYSIS

A review of the sufficiency and propriety of the declarations under 37 C.F.R. §1.131, will be addressed first.

Petitioner presents the following arguments in support of the position that the declaration under 37 C.F.R. §1.131 should be considered:

The declaration submitted by Applicant's attorney (George H. Gates) is eligible for consideration in the showing of diligence and should be considered by the Examiner, as it supplements the declarations submitted by Lee Anne Kowalski and Jeanette Berry Souza in accordance with M.P.E.P. §2138.04.

The Office action asserts that the declarations (and evidence) fail to establish conception and diligence in reduction to practice. Petitioner submits that the assertions regarding identifying claim limitations and the showing of facts versus pleadings, made by the Examiner in the Office action are erroneous.

The relevant section of the MPEP concerning consideration of evidence is set forth in MPEP § 715.07. In the language of the MPEP:

However, when reviewing a 37 CFR 1.131 affidavit or declaration, the examiner must consider all of the evidence presented in its entirety, including the affidavits or declarations and all accompanying exhibits, records and "notes." An accompanying exhibit need not support all claimed limitations, provided that any missing limitation is supported by the declaration itself. Ex parte Ovshinsky, 10 USPQ2d 1075 (Bd. Pat. App. & Inter. 1989).

When alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date. However, the actual dates of acts relied on to establish diligence must be provided. See MPEP § 715.07(a) regarding the diligence requirement.

Further, MPEP § 2138.06 sets forth (in part):

The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Reasonable diligence is all that is required of the attorney.

Therefore, the Examiner's remarks "Thus the 131 declaration signed by Applicant's legal representation is **not eligible for consideration** by the Examiner", in support of a showing of diligence by the attorney, in the final rejection of April 25, 2006, and maintained in the most recent final rejection of October 5, 2006, is inconsistent with the guidance set forth in MPEP § 715.07 and § 2138.06.

Note and with respect to Petitioner's arguments regarding the Examiner's indication of insufficiencies with respect to the evidence in support of identified claim limitations and the showing of facts versus mere pleadings, that are indicated to be "erroneous", as stated by Petitioner, are determined by this reviewing official to be in effect a review of the merits of the evidence submitted. Since, M.P.E.P. 715.08 sets forth that:

Review on the merits of a 37 CFR 1.131 affidavit or declaration is by appeal to the Board of Patent Appeals and Interferences.

It is determined that these arguments are best treated by decision under appeal before the Board.

Therefore, in accordance with current Office practice and procedures, the Examiner's determination that the declaration submitted by Applicant's legal representative is "not eligible for consideration by the Examiner" is improper.

OPINION

As a result of the relief granted for review of the sufficiency and propriety of the declaration under 37 C.F.R. §1.131, the requested relief to withdraw the finality of the October 5, 2006 Office action under 37 C.F.R. 1.181, is also granted as a matter of due course.

CONCLUSION

For the above stated reasons, the petition for supervisory review of the finality of the Office action mailed October 5, 2006 and to review of the sufficiency and propriety of the declarations under 37 C.F.R. §1.131, specifically, to consider the declaration submitted attorney George H. Gates in support of a showing of diligence by the attorney, is **GRANTED**.

The application is being forwarded to the Examiner to reopen prosecution, in particular, for consideration of the declaration filed under 37 CFR §1.131 by attorney George Gates on February 27, 2006, consistent with this decision.

Any inquiries related to this decision may be directed to Brian Johnson at (571) 272-3595.

A handwritten signature in black ink, appearing to read "Brian L. Johnson", written over a horizontal line.

Brian L. Johnson
Workgroup Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software, and Information Security